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LISA A HAILE PH.D
GRAY CARY WARE & FREIDENRICH LLP
4365 EXECUTIVE DRIVE
SUITE 1600
SAN DIEGO, CA 921212189

[REDACTED] EXAMINER

PROUTY, REBECCA E

ART UNIT	PAPER NUMBER
1652	12

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/382,242

Applicant(s)

Robertson et al.

Examiner

Rebecca Prouty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Sep 10, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1835 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 21-26 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) Claim(s) 21-25 is/are allowed.

6) Claim(s) 26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requiremen

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|--|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 20) <input type="checkbox"/> Other: _____ |

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Claims 1-20 have been canceled. Claims 21-26 are at issue and are present for examination.

Applicants' arguments filed on 9-10-01, paper No. 11, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

The terminal disclaimer filed on 9-10-01 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 5,942,430 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 is indefinite in the recitation of "medium to reduced stringency conditions" as the specification does not define what conditions constitute "stringent". While page 9-10 of the specification describes some conditions which are intended to be "medium to reduced stringency conditions", there is nothing to suggest that other conditions would not also be included within the scope of this term and in the art what is considered

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"medium to reduced stringency conditions" varies widely depending on the individual situation as well as the person making the determination. As such it is unclear how homologous to the sequence of SEQ ID NO:23, a sequence must be to be included within the scope of these claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 26 is rejected under 35 U.S.C. 102(a or b) as being anticipated by GenBank Accession No. X86487 or Kim et al. The rejection is explained in the previous Office Action.

Applicants argue that neither the nucleic acid of GenBank Accession No. X86487 nor the nucleic acid of Kim et al. has utility as a probe for an esterase as neither will specifically hybridize to SEQ ID NO:23. This is not persuasive because applicants claims are not limited to nucleic acids **consisting of** a sequence which will specifically hybridize to SEQ ID NO:23 but instead encompass any nucleic acid **comprising** a sequence which will specifically hybridize to SEQ ID NO:23. As bases 21-39 of

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the sequence of GenBank Accession No. X86487 are 100% identical to bases 360-378 of SEQ ID NO:23 and bases 5051-5069 of the gene of Kim et al. are 100% identical to bases 505-523 of SEQ ID NO:23, each of these fragments would unquestionably specifically hybridize to SEQ ID NO:23 and the nucleic acids of GenBank Accession No. X86487 and Kim et al. each clearly comprise these fragments.

Claims 21-25 are allowed. These claims are restricted oligonucleotides consisting of 15-50 contiguous nucleotides of SEQ ID NO:23. While the prior art teaches polynucleotides comprising at least 15 consecutive bases of SEQ ID NO:23 there is no suggestion in the prior art to select these specific portions of these larger polynucleotides for use as a probe.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

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pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rebecca Prouty
Primary Examiner
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